

DOCKET NO. 3829-049 NATL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Christophe NICOLAS, et al. ART UNIT: 2444
SERIAL NO.: 10/088,018 EXAMINER: Farrukh HUSSAIN
CONFIRMATION NO.: 4937
FILING DATE: March 13, 2002
FOR: METHOD AND SYSTEM FOR TRANSMITTING A CHAIN OF
MESSAGES FOR DATABASE

PETITION PURSUANT TO 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS
PO BOX 1450
ALEXANDRIA, VA 22313-1450

SIR:

Applicant respectfully requests that the office action dated June 22, 2010 in the above-captioned application (the “Office Action”) be withdrawn and that a new, non-final office action be issued for the reasons set forth below.

The Office Action Was Improperly Classified as Final

MPEP 706.07(a) provides that a second or later office action shall not be made final “where the examiner introduces a new ground of rejection that is neither necessitated by applicants amendment of the claims, nor based on information submitted in an information disclosure statement . . .” In the Office Action, the examiner rejected claim 16 under 35 U.S.C. § 103 over the combination of Deiss, Khan, Wong, and Yorimitsu. This was a new ground of rejection because it was the first time in the prosecution of this application that the examiner had

relied on the Yorimitsu reference. The Yorimitsu reference was not submitted in an IDS. Thus, in order for the Office Action to be properly classified as final, this new ground of rejection would have needed to have been necessitated by applicants amendment of claim 16. This is was clearly not the case.

Claim 16, along with claim 1, had previously been rejected as obvious over the combination of Deiss, Khan and Wong. Claim 1 had also been rejected under 35 U.S.C. § 101. In response to these rejections, applicants amended claim 16 as shown below to clarify that the steps of the method were performed by devices in order to ensure compliance with 35 U.S.C. § 101:

16. (Currently Amended) A method of exchanging, between a management center device and a plurality of distributed subscriber database devices databases, a chain of database management messages comprising a plurality of management message members, the method comprising the steps of:

- determining by the management center device dependencies between management message members to be sent as part of the chain of management messages, wherein each management message member comprises a chain header and a chain identifier and wherein said chain identifier identifies the order of transmission of said management message members of said chain;

- using by the management center device said dependencies to create a conditional block for each management message member, wherein said conditional block determines a permissible order of processing of each management message member forming a chain of management member messages;

- inserting by the management center device said conditional block into said management message member;

- transmitting by the management center device said management message member from the management center to at least one subscriber database;

- managing at the subscriber database device a table containing information representing a processing state of each member of the chain;

- determining at the subscriber database device whether the processing of each of the management message members received from the management center is subject to a condition;

- processing at the subscriber database device each management message member not subject to a condition immediately;

- processing at the subscriber database device each management message member that is subject to a condition immediately if the condition is fulfilled;

- locally storing at the subscriber database device each management message member that is subject to a condition that has not been fulfilled and later processing the management message member when the condition has been fulfilled; and

updating a table in the subscriber database device containing information representing a processing state of other members of the chain.

In addressing the obviousness rejection in the last response, Applicant further argued that neither Deiss, Khan, nor Wong disclosed the second-to-last step of “locally storing . . . when the condition has been fulfilled.” This step had been in claim 16 previously, and the change to this step of adding the word “device” was made solely to ensure compliance with §101 and had absolutely no effect whatsoever on the analysis of whether or not Deiss, Khan or Wong disclosed this step. This can be seen with reference to the basis for applicants argument in the last response (Amendment filed 3/17/10 at 13)(hereinafter, the “Amendment”).

In response to applicant’s argument in his last response, the examiner conceded in the Office Action that Deiss, Khan and Wong failed to disclose this step. *See* Office Action at 7 (stating that similar limitation in claim 1 was not present in these references) and at 9 (stating that claim 16 “recites[s] substantially the invention of claims 10, 16 and 18). Thus, the examiner relied on the newly cited Yorimitsu reference for this limitation (Office Action at 7).

Because the reason the examiner was forced to rely on the Yorimitsu reference had nothing to do with the addition of the word device to this step of claim 16, the new ground of rejection was not necessitated by applicants’ amendment of claim 16. Accordingly, pursuant to MPEP 706.07(a), the Office Action should not have been classified as final.

The Office Action Should Have Addressed Applicants’ Arguments on Combining Wong

In addition to arguing that none of Deiss, Khan or Wong disclosed the aforementioned step of claim 16, applicants set forth a detailed, page-long argument that the combination of Wong with Deiss and Khan was improper because it was non-sensical. Amendment at 14. The

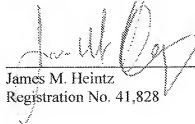
Office Action did not address this argument, claiming that it was moot. Office Action at 2. However, the new ground of rejection in the Office Action was again based on a combination of Wong with Deiss and Khan, albeit now with a fourth reference. The addition of the fourth reference to this combination does not render moot applicant's argument that Wong cannot be combined with Deiss and Khan. Furthermore, MPEP § 707.07 provides that a final rejection "should also include a rebuttal of any arguments raised in applicants reply" and that all grounds of rejection "must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal." The failure to respond to applicant's arguments that Wong cannot be combined with Deiss and Khan prevents applicant from making such a judgment and is improper, piecemeal prosecution. Applicant respectfully requests the issuance of a subsequent office action (whether or not final) that addresses this argument.

Conclusion

For the foregoing reasons, applicant respectfully request the withdrawal of the Office Action and the issuance of a new, non-final office action that addresses the argument identified above. If any further information is needed, Applicant's counsel, James M. Heintz may be reached at 202.799.4171.

Respectfully submitted,

DLA PIPER LLP (US)



James M. Heintz
Registration No. 41,828

Telephone No. 202.799.4000
Facsimile No. 202.799.5000